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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,388	09/19/2003	Marc M. Gibeley	86880THC	7524

7590 01/11/2007  
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EXAMINER
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VIEAUX, GARY

ART UNIT	PAPER NUMBER
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2622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/11/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/666,388

Applicant(s)

GIBELEY ET AL.

Examiner

Gary C. Vieaux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/19/03 and 4/13/05.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

This is a first office action in response to application 10/666,385 filed on September 19, 2003, in which claims 1-29 are presented for examination.

### 5 ***Information Disclosure Statement***

The information disclosure statements (IDS) submitted on the following dates are in compliance with the provisions of 37 CFR 1.97 and are being considered by the Examiner: September 19, 2003, and April 13, 2005.

### 10 ***Specification***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Objections***

15 **Claims 8-9, 18-23, and 27-29** are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Regarding claim 8, the claim recites the limitation "the commitment" in line 3.

20 There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 9, the claim recites the limitation "the commitment" in line 2.

There is insufficient antecedent basis for this limitation in the claim. Also, the claim

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recites the limitation "the card" in line 2. There is insufficient antecedent basis for this limitation in the claim. For purposes of evaluation of the claims, the Examiner will interpret this limitation to be read as "the memory device" based on the resemblance of claim 9 to claim 8.

5        Regarding claims 18-22, the claims each recites the limitation "the photofinishing order". There is insufficient antecedent basis for this limitation in each of the claims.

Regarding claim 23, the claim recites the limitation "include" in line 2. Please change this limitation to "includes" to create the proper verb structure.

Regarding claim 27, the claim recites the limitation "the memory" in line 2. There  
10 is insufficient antecedent basis for this limitation in the claim. For purposes of evaluation of the claims, the Examiner will interpret this limitation to be read as "the memory device". The claim also recites the limitation "the commitment" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Regarding claims 28-29, each claim recites the limitations "the filename" and "the  
15 corresponding image file" in lines 4-5. There are insufficient antecedent basis for these limitations in the claims.

### ***Claim Rejections - 35 USC § 102***

         The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that  
20 form the basis for the rejections under this section made in this Office action:

         A person shall be entitled to a patent unless –

         (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

25

**Claims 1, 14-15, 17, 20-21, and 24-26** are rejected under 35 U.S.C. 102(b) as being anticipated by Okada et al. (US 2001/0040625.)

Regarding claim 1, Okada discloses a method of providing photofinishing services, comprising the steps of a) supplying a memory device for a digital camera to a photographer (fig. 4; ¶0051), b) the photographer taking and storing a plurality of digital images on the memory device (¶0051), c) the photographer delivering the memory device containing the digital images to a photofinisher (¶0051), d) the photofinisher producing prints of the digital images and returning the prints to the photographer (¶0113), and e) the photofinisher erasing the digital images from the memory device and supplying the memory device to another photographer to repeat steps b) through e) (¶0054.)

Regarding claim 14, Okada discloses all of the limitations of claim 14 (see the 102(b) rejection to claim 1 supra) including disclosing wherein the memory device includes a protected memory area that is accessible by a supplier and the photofinisher, but not by the photographer (¶0043, ¶0087-0088, ¶0064 and ¶0098-0110.)

Regarding claim 15, Okada discloses all of the limitations of claim 15 (see the 102(b) rejection to claim 14 supra) including disclosing wherein the protected memory area contains a unique ID (¶0099.)

Regarding claim 17, Okada discloses all of the limitations of claim 17 (see the 102(b) rejection to claim 14 supra) including disclosing wherein the protected memory area contains instructions for the photofinisher provided by the supplier (¶0014; ¶0086;

¶0063, which includes providing information to correspond the image data with a particular homepage address.)

Regarding claim 20, Okada discloses all of the limitations of claim 20 (see the 102(b) rejection to claim 1 supra) including disclosing the method further comprising the  
5 step of writing an identifier unique to the photographer on the memory device and presenting the identifier unique to the photographer to the photofinisher to retrieve the photofinishing order (fig. 1B, ¶0111.)

Regarding claim 21, Okada discloses all of the limitations of claim 21 (see the 102(b) rejection to claim 1 supra) including disclosing the method further comprising the  
10 step of writing a phone number or e-mail address of the photographer on a memory device and presenting the phone number or e-mail address to the photofinisher to retrieve the photofinishing order (fig. 1B, ¶0111.)

Regarding claim 24, Okada discloses all of the limitations of claim 24 (see the 102(b) rejection to claim 1 supra) including disclosing wherein the memory device  
15 includes a prerecorded image (fig. 1A and 1B, in the form of the advertisement, the device name, and the homepage.)

Regarding claim 25, Okada discloses all of the limitations of claim 25 (see the 102(b) rejection to claim 24 supra) including disclosing wherein the prerecorded image contains instructions to a user for using the photofinishing services (fig. 1A and 1B, in  
20 the form of providing the homepage.)

Regarding claim 26, Okada discloses all of the limitations of claim 26 (see the 102(b) rejection to claim 1 supra) including disclosing the method further comprising the step of selling advertising space in the prerecorded image (fig. 1A and 1B.)

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**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

*and 28*

**Claims 2-5<sub>A</sub>** are rejected under 35 U.S.C. 103(a) as being unpatentable over

15

Okada et al. (US 2001/0040625) in view of Takano (US 2001/0041072 A1.)

Regarding claim 2, Okada discloses all of the limitations of claim 2 (see the 102(b) rejection to claim 1 supra) except for disclosing the method further comprising the steps of the photofinisher producing an index print and/or CD of the digital images from the memory device and returning the index print and/or CD to the photographer.

20

However, Okada does disclose displaying the images to a user (¶0113-0114.)

Nevertheless, Takano discloses producing and providing an index print to a digital image customer (fig. 18; ¶0083-0084.) It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a print index as taught by Takano with the method as taught by Okada so that customer may take the physical print index with them, so that they do not have to immediately decide which prints, if any, to purchase upon submission of the memory device.

25

Regarding claim 3, Okada and Takano disclose all of the limitations of claim 3 (see the 103(a) rejection to claim 2 supra) including disclosing wherein the memory device is capable of holding a number N of digital images and the photofinisher produces prints for only the first M images, where M is less than N, but the index print and/or the CD contain all N of the digital images on the memory device ('072 - fig. 18; ¶0067, ¶0083-0084.)

Regarding claim 4, Okada and Takano disclose all of the limitations of claim 4 (see the 103(a) rejection to claim 3 supra) including disclosing wherein the index print and/or the CD contain all N of the digital images on the memory device and indicates which images have or have not been printed ('072 - fig. 18; ¶0067, ¶0082-0084, in which a completed and fulfilled index print would inherently contain the images and indicate the images that had been printed.)

Regarding claim 5, Okada and Takana disclose all of the limitations of claim 5 (see the 103(a) rejection to claim 4 supra) including disclosing wherein the index print and/or the CD contain instructions for obtaining prints of the unprinted images ('072 - ¶0067, ¶0082.)

Regarding claim 28, Okada discloses all of the limitations of claim 28 (see the 102(b) rejection to claim 1 supra) except for disclosing the method further comprising the steps of the photofinisher producing an index print and CD of the digital images from the memory device and returning the index print and CD to the photographer, and indicating with at least one index image the filename of the corresponding image file



recorded on the CD. However, Okada does disclose displaying the images to a user (¶0113-0114.)

Nevertheless, Takano discloses producing and providing an index print to a digital image customer in which the image is assigned a number corresponding to the digital image (fig. 2 indicator 76, fig. 18 indicator 706; ¶0083-0084, ¶0093), as well as producing a CD on which the corresponding digital images stored (fig. 5 indicator 24 and 63; ¶0101.) It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a print index and CD, with corresponding image labels/names as taught by Takano with the method as taught by Okada so that customer may take the physical print index with them, so that they do not have to immediately decide which prints, if any, to purchase upon submission of the memory device, and so that they are not required to use a computer or other device to view potential images, as well as providing a logical method of using the CD to make later print selections by way of the matching image numbering convention.

**Claims 6, 7, and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al. (US 2001/0040625) in view of Examiner's Official Notice.

Regarding claim 6, Okada discloses all of the limitations of claim 6 (see the 102(b) rejection to claim 1 supra) except for disclosing wherein the memory device is adapted for use with a particular camera model, and further comprising the step of offering a number of different memory devices for different camera models.

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Official Notice is taken regarding the availability of different forms of memory (e.g. SD, xD, CD, PCMCIA, flash) and being well-known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to adapt a particular memory within the device of the method as taught by Okada in order to exploit a particular feature of that memory, such as transfer speed, capacity, size, or proprietary associations.

Official Notice is also taken regarding the availability of a variety of recyclable digital cameras. Based on this variety, it would have been further obvious to one of ordinary skill in the art at the time of the invention to associate a particular memory with a particular version of recyclable camera in order to best accommodate that recyclable camera's functionality, such as employing a smaller sized memory to make a smaller sized camera or employing an xD memory within a device produced by a business endeavor with Fuji or Olympus.

Regarding claim 7, Okada discloses all of the limitations of claim 6 (see the 102(b) rejection to claim 1 supra) including wherein the memory device is a CF, MMC, SD, xD, or Memory Stick.

Regarding claim 23, Okada discloses all of the limitations of claim 23 (see the 102(b) rejection to claim 1 supra) except for disclosing wherein the step of erasing the digital images from the memory device includes writing a test pattern onto the memory device.

Official Notice is taken regarding the well-known practice of writing a test pattern onto a memory device in order to verify its functionality; a concept that is well known

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and expected in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to include writing a test pattern onto the memory device as not only a way to verify its functionality, but also as a tool to effectively erase the digital images from the memory device by overwriting them with the test pattern.

5

**Claims 8, 9, 24, and 26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al. (US 2001/0040625) in view of Reifel et al. (US 7,013,288.)

10        Regarding claim 8, Okada discloses all of the limitations of claim 8 (see the 102(b) rejection to claim 1 supra) except for disclosing wherein the memory device bears a code that indicates to the photofinisher that the memory device carries with it the commitment to create prints.

15        Nevertheless, Reifel discloses a consumer being supplied with a similar memory device that bears a code that indicates to the photofinisher that the memory device carries with it the commitment to create prints (fig. 9; col. 4 lines 20-23.) It would have been obvious to one of ordinary skill in the art at the time of the invention to include a code as taught by Reifel with the memory device of the method as taught by Okada in order to visually indicate that the commitment has been entered into and the extent of the commitment, e.g. the number of prints to create.

20        Regarding claim 9, Okada discloses all of the limitations of claim 9 (see the 102(b) rejection to claim 1 supra) except for disclosing wherein the memory device

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bears a graphic that indicates that the card carries with it the commitment to create prints.

Nevertheless, Reifel discloses a consumer being supplied with a similar memory device that bears a graphic that indicates that the memory device carries with it the commitment to create prints (fig. 9; col. 4 lines 20-23.) It would have been obvious to one of ordinary skill in the art at the time of the invention to include a graphic as taught by Reifel with the memory device of the method as taught by Okada in order to visually indicate that the commitment has been entered into and the extent of the commitment, e.g. the number of prints to create.

Regarding claim 24, Okada discloses all of the limitations of claim 24 (see the 102(b) rejection to claim 1 supra) except for disclosing wherein the memory device includes a prerecorded image.

Nevertheless, Reifel discloses a consumer being supplied with a similar memory device that displays prerecorded image (col. 10 lines 9-48.) It would have been obvious to one of ordinary skill in the art at the time of the invention to include a prerecorded image, such as an advertisement, in order to generate additional revenue for the Photofinisher or reduce the device cost for the consumer.

Regarding claim 26, Okada and Reifel disclose all of the limitations of claim 26 (see the 103(a) rejection to claim 1 supra) including disclosing the method further comprising the step of selling advertising space in the prerecorded image (col. 9 line 52 – col. 10 line 48.)

**Claims 10-13 and 18-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al. (US 2001/0040625) in view of Reifel et al. (US 7,013,288), in further view of Examiner's Official Notice.

5     Regarding claim 10, Okada discloses all of the limitations of claim 10 (see the 102(b) rejection to claim 1 supra) except for disclosing wherein the memory device is returned with less than a predefined number of image files, and including the step of providing a credit to the photographer.

Reifel discloses a consumer being supplied with a similar memory device in which a contract for photofinishing services is entered into in exchange for a reduced  
10     price of the memory device (col. 4 lines 20-23.) It would have been obvious to one of ordinary skill in the art at the time of the invention to include an agreement for photofinishing services as taught by Reifel with the method as taught by Okada as a way to secure additional business or extend a business relationship.

Further, Official Notice is taken regarding the well-known practice of prepayment  
15     for goods or services and then providing a credit for unused goods or services previously purchased. It would have been obvious to one of ordinary skill in the art at the time of the invention for a user to prepay for images to be printed from the memory device and method taught by Okada and Reifel, as a way to provide advanced notice to the photofinisher that a certain number of images will potentially be ordered, thereby  
20     assisting in the prediction of available cash flow and more accurate bookkeeping, and then to further provide a credit for the unused image amounts so that the user is fairly

charged for the only prints produced, and so that a more equitable business arrangement would also be created.

Regarding claim 11, Okada, Reifel, and Examiner's Official Notice discloses all of the limitations of claim 11 (see the 103(a) rejection to claim 10 supra) except for

5 disclosing wherein the credit is in the form of a coupon.

Nevertheless, Official Notice is also taken regarding the well-known practice of providing a coupon as a form of credit, such as a store credit receipt. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the credit in the form of a coupon in order to prevent the credit from being applied

10 elsewhere, and therefore assisting in retaining business profits previously predicted and accounted.

Regarding claim 12, Okada, Reifel, and Examiner's Official Notice discloses all of the limitations of claim 12 (see the 103(a) rejection to claim 10 supra) except for disclosing wherein the credit is in the form of a debit card that is returned with the prints.

15 Nevertheless, Official Notice is also taken regarding the well-known practice of providing a debit card as a form of credit. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the credit in the form of a debit card in order to prevent the credit from being applied elsewhere, and therefore assisting in retaining business profits previously predicted and accounted.

20 Further, Official Notice is also taken regarding the well-known practice of not returning a credit until after a full accounting of the good or services have been rendered. It would have been obvious to one of ordinary skill in the art at the time of the

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invention to wait to provide the credit until the prints are produced for the end user so that an accurate accounting of the amount to be credited can be determined.

Regarding claim 13, Okada discloses all of the limitations of claim 13 (see the 102(b) rejection to claim 1 supra) except for disclosing wherein a debit card for

- 5 photofinishing services is supplied to the photographer along with the memory device and the debit card is presented to the photofinisher along with the memory device.

Reifel discloses a consumer being supplied with a similar memory device in which a contract for photofinishing services is entered into in exchange for a reduced price of the memory device (col. 4 lines 20-23.) It would have been obvious to one of  
10 ordinary skill in the art at the time of the invention to include an agreement for photofinishing services as taught by Reifel with the method as taught by Okada as a way to secure additional business or extend a business relationship.

Further, Official Notice is taken regarding the well-known practice of providing a debit card, associated with a bank or a financial institution, to a provider of goods or  
15 services in order to provide authorization for payment, and then later providing the debit card again to provide payment for the goods or services once rendered, such as for the prior authorization and then payment of a hotel stay by way of a debit card. It would have been obvious to one of ordinary skill in the art at the time of the invention to employ a debit card in an analogous manner in which a debit card would be presented  
20 to the photofinisher for authorization for photofinishing services, and then given back to the user along with the memory device, and then presented again along with the

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memory device when the photofinishing services were to actually be provided, and in doing so, fulfilling the quid pro quo arrangement of money for goods and services.

Regarding claim 18, Okada discloses all of the limitations of claim 18 (see the 102(b) rejection to claim 1 supra) except for expressly disclosing the method further comprising the steps of supplying a claim card for retrieving photofinishing services to the photographer along with the memory device and presenting the claim card to the photofinisher to retrieve the photofinishing order. However, Okada does disclose providing a password on the camera packaging to be kept by the user and employed to access images via the Internet (§0095.)

Nevertheless, Official Notice is taken regarding the well-known practice of providing a claim card to an individual who is transferring control of an item, in order to associate an individual with an item, and then that individual presenting the card in order to reclaim control of that item at a later point in time, similar to the method employed in the dry cleaning industry or with valet parking. It would have been obvious to one of ordinary skill in the art at the time of the invention to employ a claim card in an analogous manner with the method as taught by Okada in order to associate the memory device and the corresponding order with the user in an analogous manner.

Regarding claim 19, Okada discloses all of the limitations of claim 19 (see the 102(b) rejection to claim 1 supra) except for expressly disclosing the method further comprising the steps of supplying a removable tag for retrieving photofinishing services to the photographer along with the memory device and presenting the removable tag to the photofinisher to retrieve the photofinishing order. However, Okada does disclose



providing a password on the camera packaging to be kept by the user and employed to access images via the Internet (§0095.)

Nevertheless, Official Notice is taken regarding the well-known practice of providing a removable tag to an individual who is transferring control of an item, in order to associate that individual with an item, and then that individual presenting the tag in order to reclaim control of that item, similar to the method employed in the dry cleaning industry or with valet parking. It would have been obvious to one of ordinary skill in the art at the time of the invention to employ a removable tag with the method as taught by Okada in order to associate the memory device and the corresponding order with the user in an analogous manner.

**Claim 16** is rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al. (US 2001/0040625) in view of Yamashina et al. (JP 05-093950 A.)

Regarding claim 16, Okada discloses all of the limitations of claim 16 (see the 102(b) rejection to claim 14 supra) except for expressly disclosing wherein the protected memory area contains a number indicating the number of times that the memory device has been recycled.

Nevertheless, Yamashina discloses indicating the number of times a camera component has been recycled (Abstract.) It would have been obvious to one of ordinary skill in the art at the time of the invention to include the number of times the memory device has been recycled within the protected memory area as taught by Yamashina with the method as taught by Okada in order to help maintain a stable level of quality.

**Claim 22** is rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al. (US 2001/0040625) in view of Maginness et al. (US 4,870,257.)

Regarding claim 22, Okada discloses all of the limitations of claim 22 (see the 102(b) rejection to claim 14 supra) except for disclosing a method further comprising the

5 step of writing a phone number or e-mail address of the photographer on a photofinishing envelope and presenting the phone number or e-mail address to the photofinisher to retrieve the photofinishing order. However, Okada does disclose providing a password on the camera packaging to be kept by the user and employed to access images via the Internet (§0095), as well as writing a phone number or e-mail

10 address of the photographer on a memory device and presenting the phone number or e-mail address to the photofinisher to retrieve the photofinishing order (fig. 1B, §0111.)

Maginness discloses a photofinishing method in which a user provides their name and address on a photofinishing envelope containing image information to be produced as prints (col. 3 lines 38 – col. 4 line 27.) In light of the teachings of

15 Maginness, it would have been obvious to one of ordinary skill in the art at the time of the invention to employ a photofinishing envelope to hold the memory device, in which the photofinishing envelope had the phone number or e-mail address of the photographer on it instead of on the memory device, with the method of Okada in which a phone number or e-mail address is used to retrieve the photofinishing order, in order

20 to provide a way to transport the memory device without exposing the password to a possible unauthorized user, while still being able to associate the memory device with the intended user for retrieval of the photofinishing order.

**Claim 27** is rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al. (US 2001/0040625) in view of Reifel et al. (US 7,013,288), in further view of Rubstein et al. (US 2003/0061566 A1.)

Regarding claim 27, Okada discloses all of the limitations of claim 27 (see the 102(b) rejection to claim 1 supra) except for disclosing wherein the memory device bears a code in a hidden file or psuedo bad sector of the memory device that indicates to the photofinisher that the memory device carries with it a commitment to create prints.

Reifel discloses a consumer being supplied with a similar memory device that bears a numerical code that indicates that the memory device carries with it the commitment to create prints (fig. 9; col. 4 lines 20-23.) It would have been obvious to one of ordinary skill in the art at the time of the invention to include a numerical code as taught by Reifel with the memory device of the method as taught by Okada in order to visually indicate that the commitment has been entered into and the extent of the commitment, e.g. the number of prints to create.

Further, Rubstein discloses placing a hidden file in a memory device (§0052.) In light of the teachings of Rubstein, it would have been further obvious to one of ordinary skill in the art at the time of the invention to provide a hidden file in the memory device as taught by Okada and Reifel in order to provide the photofinisher with the amount of prints committed to, while making the numerical commitment on the memory device more difficult to tamper with or alter.

**Claim 29** is rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al. (US 2001/0040625) in view of Takano (US 2001/0041072 A1), in further view of Hunter (US 7,139,095.)

Regarding claim 29, Okada discloses all of the limitations of claim 29 (see the 102(b) rejection to claim 1 supra) except for disclosing the method further comprising the steps of the photofinisher producing at least one print and a CD of the digital images from the memory device and returning the at least one print and CD to the photographer, and indicating on the at least one print the filename of the corresponding image file recorded on the CD. However, Okada does disclose displaying the images to a user (§0113-0114.)

Nevertheless, Takano discloses producing and providing an index print to a digital image customer in which the image is assigned a number corresponding to the digital image (fig. 2 indicator 76, fig. 18 indicator 706; §0083-0084, §0093), producing a CD on which the corresponding digital images stored (fig. 5 indicator 24 and 63; §0101), and producing prints therefrom (§0096-0107.) It would have been obvious to one of ordinary skill in the art at the time of the invention to produce a print and a CD of the digital images and to then provide them to the end user so that he can have hard copies and digital copies of the images. However, neither Okada nor Takano disclose indicating on the at least one print the filename of the corresponding image file recorded on the CD.

Hunter discloses producing a print in which a unique identifier and image number are provide, the unique identifier and image number corresponding to that found in the

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digital memory (fig. 7; col. 4 lines 25-61.) It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the use of a unique identifier and an image number on a print containing an image that corresponds to a digital version of the image, with the method as taught by Okada and Takano, so that a user can quickly  
5 identify the image, via the identifier or number, for creating additional printouts.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10 Nakayama (US 2001/0009602 A1) discloses a method of providing photofinishing services employing a recyclable memory card.

Kinjo (US 2003/0086706 A1) discloses an order processing method.

Bouchard et al. (US 6,842,186) discloses a recyclable digital camera.

Braunstein et al. (US 7,126,629) discloses a recyclable digital camera.

15 Ichikawa (US 6,644,455) discloses a method for providing rental cameras.

Takaba et al. (US 2001/0022617 A1) discloses a recyclable digital camera.

Shirai (US 2003/0048358 A1) discloses a digital camera recycle system.

Butler et al. (US 4,894,920) discloses generating a refund for an unused portion of a product.

20 Murashita et al. (US 2004/0201683 A1) discloses a recyclable memory dispensing system.

Minne et al. (US 6,950,129) discloses a one-time-use digital camera.

Silverbrook (US 6,970,186) discloses a one-time-use digital camera exchange system.

### Contact

5 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Vieaux whose telephone number is 571-272-7318. The examiner can normally be reached on Monday - Friday, 8:00am - 4:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NgocYen T. Vu can be reached on 571-272-7320. The fax phone number  
10 for the organization where this application or proceeding is assigned is 571-273-8300.

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15 For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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